



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of: A. J. Paul Carew, et al.
Serial No.: 09/724,603
Filing Date: November 28, 2000
Examiner: Inder P. Mehra
Art Unit: 2666
Title: SYSTEM AND METHOD FOR COMMUNICATING
TELECOMMUNICATION INFORMATION FROM A
BROADBAND NETWORK TO A
TELECOMMUNICATION NETWORK

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Advisory Action mailed January 5, 2006, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005. Pursuant to the Official Gazette Notice, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

Claims 1, 13, 28, and 38 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1, 4, 5, 7, 9, 10, 13, 15, and 18 of U.S. Patent No. 6,526,046. Claims 1, 4, 5, 7, 9, 10, 13, 15, and 18 of U.S. Patent No. 6,526,046 do not provide for extraction of telecommunication information from a data packet as required in Claims 1, 13, 28, and 38 of the present Application. Thus, the two sets of claims are directed to completely different and opposite modes of operation. The Examiner inappropriately equates the data packets to the telecommunication information as the former is the mechanism for carrying the latter. Accordingly, a Terminal Disclaimer is not needed to overcome this rejection as obviousness-type double patenting does not apply to this Application when compared to U.S. Patent No. 6,526,046.

Claims 1-4, 13-16, 28-31, and 38-41 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Focsaneanu, et al. in view of Chao, et al. and further in view of Gerszberg, et al. In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish a prima facie case of obviousness. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

Independent Claims 1, 13, 28, and 38 recite in general the ability to interface with first and second data

communication protocols that include IP, ATM, and Frame Relay. These claims also recite that the associated broadband networks providing data packets can be any of digital subscriber line, cable, or wireless platforms. These claims also recite that the telecommunication interface formats may be any of GR-303, TR-8, SS7, V5, ISDN, and unbundled analog lines. By contrast, the Examiner readily admits that the Focsaneanu, et al. patent fails to disclose the ability to interface with first and second data communication protocols and also fails to disclose the types of broadband networks and telecommunication interface formats provided in the claims. The Chao, et al. patent is merely directed to an optical customer premises network for interfacing customer premises equipment. The portion of the Chao, et al. patent cited by the Examiner is concerned with a protocol for handling multiple priorities. The unique protocol discussed in the Chao, et al. patent is a contention protocol to provide fair access to the upstream bus for all units. The contention protocol of the Chao, et al. patent hardly equates to the first and second data communication protocols and the interfacing therewith as provided by the claimed invention. Thus, the contention protocol for providing fair access to the upstream bus mentioned by the Chao, et al. patent is totally unrelated to interfacing with first and second data communication protocols as required by the claimed invention. The Gerszberg, et al. patent merely provides for different services over only a single type of communication capability to and from its customer premises.

Based on the above discussion, the structure that would result from placing the unique protocol for contention determination of the Chao, et al. patent and the single communication type capability of the Gerszberg, et al. patent into the network of the Focsaneanu, et al. patent would still lack an ability to provide information to a subscriber in one

of various telecommunication interface formats received from one of various broadband networks using one of various data communication protocols as required by the claimed invention. The Examiner has failed to show that the proposed combination provides an ability to handle data packets from any of digital subscriber line, cable, and wireless platforms carried by any of IP, ATM, or Frame Relay protocols and provided to subscribers over any of GR-303, TR-8, SS7, V5, ISDN, or unbundled analog line types of telecommunication interface formats as required by the claimed invention. Therefore, Applicant respectfully submits that Claims 1-4, 13-16, 28-31, and 38-41 are patentably distinct from the proposed Focsaneanu, et al. - Chao, et al. - Gerszberg, et al. combination.

Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action of September 27, 2005 and the Advisory Action of January 5, 2005 to establish a prima facie case of obviousness of the claims in the Application. There has been no mention of the three criteria for a prima facie case of obviousness as spelled out in M.P.E.P. §2143. The Examiner only provides a baseless subjective and conclusory "it would have been obvious" statement for combining the Focsaneanu, et al., Gerszberg, et al. and Chao, et al. patents without providing any objective reasoning or citing any evidence of record to support such a position. The Examiner has not provided any reasons how the proposed Focsaneanu, et al. - Gerszberg, et al. - Chao, et al. combination would have any expectation of success let alone a reasonable expectation of success. As shown above, the proposed combination fails to teach or suggest all of the claim limitations. As a result, the Examiner has failed to establish a prima facie case of obviousness in this Application.

CONCLUSION

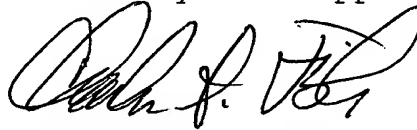
Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant



Charles S. Fish

Reg. No. 35,870

January 23, 2006

Correspondence Address:

2001 Ross Avenue, Suite 600

Dallas, Texas 75201-2980

(214) 953-6507

Customer Number: 05073